

## REMARKS

Claims 2 - 16, 25 - 26, 30 - 31 and 38 - 44 remain active in this application. New dependent claim 45 has been presented. Claims 1, 17 - 24, 27 - 29 and 32 - 37 have previously been canceled. The Examiner has withdrawn claims 2, 5 - 9, 12, 25, 26, 31 and 38 - 44 from consideration as being constructively non-elected. Claims 3, 4, 10, 11, 13, 38, 42 and 44 have been amended. Support for the amendments of these claims is found throughout the application, particularly on page 11 and in other claims. No new matter has been introduced into the application.

Following a requirement for restriction and an election, with traverse, responsive thereto, the Examiner has held constructive election, contrary to the election made, to have occurred and has held claims. This holding by the Examiner is respectfully traversed, particularly as being moot in view of the amendments made above.

The Examiner has held claims 2, 5 - 9, 12, 25, 26, 31 and 38 - 44 to be directed to an invention which is patentably distinct from the invention previously examined by not requiring "simultaneously applying powdered metal into the heated area while heating the heated area". In response, claims 38 and 44 have been amended to include the language "while continuing said step of heating said die body" as recited in, for example, claims 3 and 10 which the Examiner has considered to be drawn to the constructively elected invention and has not withdrawn from consideration. Therefore, it is respectfully submitted that the requirement for restriction and holding of constructive election is moot and should be withdrawn and an action given on all claims.

More importantly however, it is respectfully submitted that for restriction to be required (which is

a condition precedent to a holding of constructive election) the Examiner must demonstrate not only independence or distinctness of the different inventions identified but also the existence of a serious burden of examination in the absence of a requirement for restriction. In this case, the Examiner has merely asserted that claims 2, 5 - 9, 12, 25, 26, 31 and 38 - 44 are broader than those previously examined in regard to the concurrency of applying powdered metal and continuation of heating. Thus, by the Examiner's analysis, claims 2, 5 - 9, 12, 25, 26, 31 and 38 - 44 should be regarded as *comprehending* the invention held to be constructively elected rather than being restrictable therefrom. Moreover, in regard to any serious burden of examination, it is respectfully pointed out that the search for the inventions identified by the Examiner should be substantially congruent rather than divergent although the search area might be expanded to due to increased claim breadth which Applicant has the right, in a non-final action, to present. Again, however, it is respectfully submitted that this issue is now moot in view of the above amendments.

Further, it is well-established policy of the USPTO as enunciated in the M.P.E.P. that restriction should not be required where an action can be given on all claims without a serious burden. Since the Examiner has taken action on claims 3, 4, 10, 11 and 30 which variously depend from claim 38 which the Examiner has withdrawn from consideration, it is clear on the record that the Examiner has, in fact, already considered the subject matter of at least independent claim 38 (to which independent claim 44 closely corresponds) and no serious burden of examination can exist in view of the consideration already given to the subject matter of claims that the Examiner has withdrawn from consideration.

Additionally, it is respectfully submitted that the requirement for restriction and holding of constructive election now asserted by the Examiner is prejudicial following a requirement for restriction in which constructive election was not held to have occurred since unnecessary delays have been engendered thereby in an application in which the prosecution has already become protracted. Again, the Examiner's attention is respectfully called to the interview by telephone with Examiner Alie and Supervisor Shoap on September 6, 2005, during which the undersigned was assured that constructive election would not be held to have occurred. Accordingly, taking an action contrary to that interview is not only without basis and contrary to established USPTO policy as pointed out above, but also a cause of unnecessary delay in consideration of the merits of the subject matter claimed and seeking to justify an *incomplete office action* and clearly directed to forcing the addition of unnecessary or trivial recitations in the claims or filing of a further continuing application to obtain the substantive consideration of the claimed subject matter to which Applicants are entitled.

Accordingly, it is respectfully submitted that the current requirement for restriction and holding of constructive election are improper and, in any case, now moot in view of the amendments made above. Therefore, it is respectfully requested that the requirement for restriction and holding of constructive election be reconsidered and withdrawn.

The Examiner has objected to claims 3, 4, 10, 11 and 30 due to their dependency from claim 38 which the Examiner assert does not comply with M.P.E.P. §608.01(m), to which the Examiner does not otherwise object. This objection is respectfully traversed as being moot in view of the above amendments to claim 38 in which periods (".") in labels of particular steps

have been deleted. Similar amendments have also been made in claims 42 and 44. Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Claims 3, 4, 10 and 11 have been rejected under 35 U.S.C. §112, second paragraph as being indefinite; the Examiner raising particular criticisms of each claim included in this ground of rejection. This ground of rejection is respectfully traversed, particularly as being moot in view of the amendments made above.

In regard to lines 2 and 6 of claim 10, it is respectfully submitted that antecedent language for "said die body material" appear in paragraph a) of claim 38. In regard to all other criticisms by the Examiner, amendments made above directly address and resolve the criticisms noted. Accordingly, it is respectfully requested that this ground of rejection be reconsidered and withdrawn.

Claims 3, 4, 10, 13, 14, 16 and 30 have been rejected under 35 U.S.C. §103 as being unpatentable over Baker in view of Maybon and claims 11 and 15 have been rejected under 35 U.S.C. §103 as being unpatentable over Baker in view of Maybon and Cox et al. These grounds of rejection are respectfully traversed for the reasons of record and, further, as being moot in view of the amendments made above.

Specifically, the Examiner has not addressed the recitations of forming a puddle of melted die body material and applying the powdered blade material to the puddle of claims 3, 4, 10, 11 and 30 by their dependency from claim 38 and thus has not made a *prima facie* demonstration of obviousness of any of these claims. Corresponding recitations have now been added to claims 13 - 16 by amendment to claims 13 and 16. These recitations support the numerous unexpected meritorious effects of the invention in achieving a particular concentration profile of blade material in

the bead produced such that the hardness is maximized throughout regions of the bead away from the die body material as well as a particular bead shape which requires very little shaping or machining to achieve the desired cutting geometry and which leaves the hardest material in the bead at the cutting surfaces of the blade so formed.

The prior art does not teach or suggest any of these features or lead to an expectation of success in achieving the meritorious effects of the invention and thus neither answer the subject matter of the claims nor provide evidence of a level of ordinary skill in the art which would support the conclusion of obviousness which the Examiner has asserted. Further, the Examiner's statement of the rejection attributes little more to the references in combination than heating a die body with a laser beam and applying a powdered blade material of greater hardness where the laser beam can melt it and without any further specificity as to the application of powdered blade material by which any of the advantageous and unexpected meritorious effects of the invention can be produced.

In this regard, the present action notes that claims 13 - 16, as currently rejected as the same as claims as to which the rejection was affirmed on Appeal. It is respectfully pointed out that the Board of Patent Appeals and Interferences did not directly affirm the rejection of these claims and, while Applicant may be bound by indicating that these claims should stand or fall with other claims for purposes of that Appeal the rejection thereof was not, in fact, affirmed on Appeal. In any case, claim 13 has been amended above and a new claim 45 has been presented depending from claim 16. Applicant has no objection to combining claims 45 and 16 or amending claim 16 in much the same manner as claim 13 however, claim 16 is not

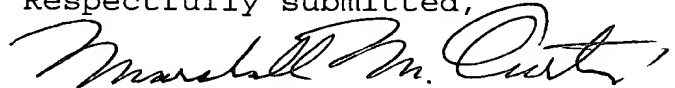
amended at this time in the event the Examiner might find such an amendment not to be consonant with the requirement for restriction and/or constructive election traversed above.

Accordingly, the asserted grounds of rejection are seen to be clearly in error as failing to make a *prima facie* demonstration of obviousness and essentially ignoring explicit recitations of the claims as well as being grounded in hindsight. Therefore, reconsideration and withdrawal of these grounds of rejection are respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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